

REMARKS

Status of the Claims

Claims 24-51 are present in this application. Claims 24, 31, 33, 36, 39, 41, 43, 44 and 48 are independent.

Claims 24-43 have been previously withdrawn. Reconsideration of this application is respectfully requested.

Priority under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Obviousness-Type Double Patenting Rejection

Claims 44-51 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-9 of U.S. Application No. 12/152,016. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

The factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness-type double patenting analysis are missing from the Office Action with respect to independent claims 44 and 48.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole", not just a small part of the preamble of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under § 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the

claims must be considered in their entirety. See *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983). By failing to address all of the features of claims 44 and 48, the rejection fails to evaluate the invention as a whole and the rejection is improper and should be withdrawn.

Moreover, as pointed out in MPEP 804, because the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis.

These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Furthermore, a rejection must be based on objective factual evidence rather than mere conclusory statements by an Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Absolutely no objective factual evidence is presented in support of this speculative conclusion of obviousness. Instead, the rejection is phrased in terms of anticipation rather than obviousness in that the rejection is based on overlapping ranges.

Applicants respectfully submit that a *prima facie* case of double patenting has not been established because the Office Action fails to even discuss (1) the nitride semiconductor feature of independent claims 44 and 48, and the specific dopant elements recited in claims 44 and 48, and the single crystal phosphor characteristic recited in independent claims 44 and 48; or (2) where these positively recited features of the claims under rejection are found in claims 5-9 of Serial No. 12/520,016, which has now matured into U.S. Patent 7,855,385, or (3) point out all of the differences between each and every one of claims 44-51 of this application and claims 5-9 of U.S. Patent 7,855,385, i.e., not just dopant concentration features..

Moreover, the rejection is not stated in terms of the claims, but in terms of the “level of dopant concentration in each application (emphasis added).” In view of this statement, it appears that this rejection is improperly based on the entire application, not just the claims, whereas a proper basis for a double patenting rejection must be based on only the claims. Moreover, as noted above, this rejection is improperly based on fewer than all of the features positively recited in claims 44-51 of this application, and improperly fails to demonstrate why the unspecified differences between claims 44-51 of this application and claims 5-9 of U.S. Patent Application 7,855,385 are obvious variations of claims 5-9 of U.S. Patent 7,855,385.

In other words, Applicants respectfully submit that whether or not the claims of these copending applications do recite some features in common, this rejection fails to compare each and every feature of Applicant’s claimed invention with each and every feature of U.S. Patent 7,855,385’s claims 5-9, or to state what all of the differences are therebetween, or to address the obviousness or non-obviousness of the differences, as required by *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

Moreover, no objective factual evidence is presented to establish that proper motivation by one of ordinary skill in the art exists to modify claims 5-9 of the U.S. Patent 7,855,385 to arrive at the invention recited in Applicants’ claims 44-51. In fact, the issue of proper motivation is not even discussed. Instead the rejection merely concludes what is needed to do to arrive at the claimed invention (only in terms of choosing among overlapping ranges) and overlooks meeting the Office’s burden of providing objective factual evidence of proper motivation to perform the choosing.

Additionally, in order to be considered fully responsive to the outstanding Office Action, Applicants respectfully present the following reasons why claims 44-51 patentably distinguish over claims 5-9 of Serial No. 12/152,016 (now, U.S. Patent 7,855,355).

Firstly, independent claims 44 and 48 recite a combination of features, including a 6H-SiC single crystalline phosphor. However, claims 5-9 of Serial No. 12/152016 (now, U.S. Patent 7,855,355) clearly do not recite either a 6H-SiC phosphor or a single crystalline phosphor. Nor is any objective evidence presented of such a combination of features, or of why such features are obvious.

Secondly, independent claims 44 and 48 recite a combination of features, including a nitride semiconductor device, whereas none of claims 5-9 of Serial No. 12/152,016 (now, U.S. Patent 7,855,355) recite such a feature. Nor is any objective evidence presented of such a combination of features, or of why such features are obvious.

Accordingly, the Office Action fails to make out a *prima facie* case of non-statutory obviousness-type double patenting.

Reconsideration and withdrawal of this rejection of claims 44-51 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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